

Application No. 10/656,936  
Response to Office Action dated November 30, 2006  
Paper dated February 22, 2007  
Attorney Docket No. 1381-031188

### REMARKS

Applicant respectfully requests reconsideration of the rejection of the claims. This Amendment amends claims 1, 4 and 21, and adds new dependent claims 22 and 23. Claims 5-7 remain as originally filed. A total of 8 claims remain in the case.

Claim 1 is amended to recite further distinctions not found in the cited references. Support for these amendments is found in the specification in at least paragraphs [0018], [0020] and [0025], and Figure 2B. Claim 4 is amended to clarify that both prong members have a pointed end and barbs along their lengths. Claim 21 is amended to overcome the Section 112 rejection to this claim and for clarification purposes. New claim 22 further defines the flat portion and the step portion as represented particularly in Figure 2B. New claim 23 recites that the clip is structured for use with sound absorbing media used with roof decks.

#### Claim Rejection Under 35 U.S.C. 112

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claim 21 to change “the second portion” in the last line to read “the step portion”. Additional amendments have been made to the claim 21 to recite “the first prong member and the second prong member” in the third line for clarity purposes.

In view of the amendments to claim 21, Applicant requests that the rejection to the claims on this basis be withdrawn.

#### Claim Rejections Under 35 U.S.C. 102

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Logsdon, U.S. Patent No. 3,684,223 (the Logsdon reference).

The claimed invention, particularly amended claim 1, relates to a clip having a body with two sides, a flat portion between the two sides, a step portion on the flat portion, the flat portion with portions located on opposite sides of the step portion, a first prong member projecting outward from the first side of the body and a second prong member projecting outward from the second side of the body. The entire clip member comprising the body and its several portions and prong members are formed from a single blank member via a stamping process, and thereafter the body is bent in one direction to form step portion 14, and the prong

members 16, 17 are bent in an opposite direction as disclosed in the specification and as illustrated in Figures 2A-2D. As now defined in amended claim 1, the step portion has an open faced recess projecting outwardly in the first direction (shown in Figure 2B). The prong members 16, 17 are straight, unbent single length members, each having a pointed end and barbs along its length for penetrating a substrate, such as a sound-absorbing media 2 (Figure 4 and new claim 23) and anchoring the clip in the substrate. Further distinctions of the clip of the invention have now been added to amended claim 1. Additionally, as claimed in new claim 22, the portions of the flat portion located between the two sides of the body and opposite to the step portion 14 (shown better in Figure 2B) have a smooth and continuous undersurface extending between the step portion 14 and the prong members 16, 17. As recited in new claim 23, this clip is structured for use with sound absorbing media used with roof decks.

The Examiner's position is that the Logsdon reference shows a clip comprising a body having a first side and a second side 28 (left and right), a flat portion 30 between the first side and the second side, a step portion 16 located on the flat portion, with portions 30 of the flat portion located on opposite sides of the step portion 16, a first prong member 32 (the outermost one) projecting outward from the first side of the body, a second prong member projecting outward from the second side of the body, with the first and second prong members bent transverse to the body in the first direction and the step portion is transverse to the body in the second direction. Also, the clip is polymeric.

There are several distinctions between this reference and the claimed invention of amended claim 1. First, the clamp of the Logsdon reference is a pipe clamp for holding a pipe in place; whereas the structure of the clip of the claimed invention allows for its particular use in a substrate, e.g., with sound absorbing media used with roof decks (new claim 23). Second, the clamp of the Logsdon reference is preferably formed as a unitary body of a polyolefin material such as polypropylene by present-day injection molding techniques (column 2, line 61-64); whereas the clip of the claimed invention is formed from a metal blank member via a stamping process and then bent to form the prong members projecting in one direction and to form the step portion projecting in the opposite direction. Third, the clamp of the Logsdon reference has several smooth surfaces 30 alternating with several ribs 32 (Figures 2 and 4) for engaging mounting stud 14 (Figure 2) to firmly hold the clamp and which ribs 32 operate substantially the

same way as the ridges 22 to prevent sound vibrations being transmitted to mounting stud 14 (column 4, lines 24-28); whereas, the clip of the claimed invention has a step portion with an open faced recess projecting outwardly in the first direction. Fourth, the clamp of the Logsdon reference has flanges 28 and holes 38 for receiving nails 36 which attach the clamp 10 to mounting stud 14; whereas the clip of the claimed invention has two prong members for penetrating and retaining the clip 10 in a substrate, for example, a sound-absorbing media 2 (paragraph [0023] of the specification).

In view of the above comments and amendments to the claims, particularly claim 1, Applicant respectfully requests that the rejections of the claims on this basis be withdrawn. Claim 7 is patentable on its own merits in addition to being dependent on a patentable claim 1. Also, new claims 22 and 23 are patentable for the reasons given hereinabove.

Claims 1, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Frey et al., U.S. Patent No. 4,793,335 (the Frey reference).

The Examiner's position is that the Frey reference (Figure 1) shows a clip comprising a body having a first side and a second side (Figure 2), where the narrower parts are a flat portion 2 (Figure 1) between the first side and the second side, a step portion 1 located on the flat portion, with portions of the flat portion located on opposite sides of the step portion. A first prong member 6 projects outward from the first side of the body and a second prong member 6 projects outward from the second side of the body, with the two prong members bent transverse to the body in a first direction. A step portion is transverse to the body in the second direction. The clip is a metal material, and the first prong has a pointed end and at least one barb along a length of the first prong member.

The Frey reference relates to a surgical agraffe for fixing artificial ligaments and tendons to a bone. This device is comprised of a deformable metal plate 1 defining a connecting bridge element of substantially square shape (Figure 2) and a pair of projections 2 which extend from opposite sides of the bridge element. Each projection 2 is of fishplate-type shape and each has an eyelet 3 which is surrounded by an upstanding wall or lip 4 in which a thread 5 is cut. Eyelets 3 receive pins 6 (column 2, lines 45-65).

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Again, there are several differences between the claimed invention as set fourth in amended claim 1 and the Frey reference. First, the surgical agraffe of the Frey reference is used to attach artificial ligaments and tendons to a bone; whereas the clip of the claimed invention is structured for particular use with a substrate sound absorbing media used in roof decks. Second; the first and second prong members 6 of the Frey reference are pins 6 which are separate pieces from the plate 1 and which pins 6 are inserted into eyelets 3 formed in projections 2; whereas the first and second prong members 16, 17 of the claimed invention are formed by bending a one-piece blank member formed in a stamping process.

In view of the above comments and amendments to claim 1, Applicant respectfully requests that the rejection of the claims on this basis be withdrawn. Claims 4 and 7 are patentable on their own merits in addition to being dependent on a patentable claim 1.

Claims 1 and 21 are rejected under U.S.C. 102(b) as being anticipated by Kuffel, U.S. Patent No. 5,759,004 (the Kuffel reference).

The Examiner's position is that this reference shows a clip comprising a body having a first side and a second side, a flat portion (the flat part adjacent to and below the vertical part which is next to part 14, Figure 3) between the first side and the second side, a step portion 14 (and the vertical part) located on the flat portion, with portions of the flat portion located on opposite sides of the step portion. A first prong member 18 projects outward from the first side of the body and a second prong member 18 (the other side) projects outward from the second side of the body, with the first and second prong members bent transverse to the body in a first direction and the step portion is transverse to the body in a second direction. The material thickness for the flat portion, the step portion, the first prong member and the second prong member is uniform, and the planar width of the two prong members 18 is less than the planar width of the flat portion and the step portion (the prongs 18 end where the prongs start to widen).

The Kuffel reference relates to a pushmount for securing a bundle of wires by a metal cable tie to a mounting surface; whereas the clip of the claimed invention can be attached to a sound-absorbing media and used as a spacer. The pushmount of the Kuffel reference is a one-piece mount formed from metal and has a pair of attached spaced apart resilient retaining legs 18. Each leg 18 is formed so as to be reversely bent upon itself such that as legs 18 are inserted into hole 32 of mounting surface 30, both legs 18 in their entirety and the individual

reversely bent portions of legs 18 are flexed inwardly as shown in Figure 7. As the ends of the reversely bent portions of legs 18 pass completely through holes 32, the spring forces created push them outwardly. As legs 18 spring outwardly, centering tabs 22, which are part of legs 18, abut against mounting surface 30 from within hole 32. (See column 2, lines 27-43, and Figure 8.)

A difference between this pushmount of the Kuffel reference and the clip of the claimed invention as set forth in amended claim 1 is the structure of the prongs of the invention versus that of the retaining legs of the Kuffel reference. The retaining legs 18 of the Kuffel reference are comprised of bent portions which act as a spring to allow legs 18 to spring inward when entering hole 32 of mounting member 30, and then spring outward when legs 18 are completely in hole 32. Each leg 18 has a centering tab 22 formed as an inwardly offset extension of the reversely bent leg portions 18 for abutting against the mounting surface 30 for retaining the pushmount 10 in the hole 32 of the mounting plate 30. In contrast to this, the prong members 16, 17 of the claimed invention are of a simple structure in that they are straight, unbent single length members, as now recited in amended claim 1. Also, the prong members 16, 17 are retained in a substrate via barbs as recited in claim 4, making the complicated structure of the retaining legs 18 of the Kuffel reference unnecessary in the claimed invention.

In view of the above comments and amendments to the claims, particularly amended claim 1, Applicant respectfully requests withdrawal of the rejections of the claims on this basis. Claim 21 depends on claim 1, and therefore is patentable, in addition to being patentable on its own merits.

Rejection of Claims Under 35 U.S.C. 103

Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious in view of the Logsdon reference. The Examiner's position is that this reference shows all the claimed limitations except for the step portion having a radius of .25-.5 inch, and that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the structure of this reference to show the step portion having a radius of .25-.50 inch because this radius would enable the clamp to fasten to a pipe of .25-.50 inch since pipes having this diameter are well-known used size pipes in a household for utility.

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The argument propounded above for the patentability of amended claim 1 over the Logsdon reference applies here with equal force. As argued hereinabove, the clip of the claimed invention has many patentable distinctions not found in the Logsdon reference and these limitations now appear in amended claim 1. To emphasize, the clip of the claimed invention is structured for particular use with a substrate, for example, with a sound-absorbing media used with roof decks; whereas the clamp of the Logsdon reference is used for holding a pipe so as to isolate sound, prevent electrolysis and minimize heat transmission while avoiding pipe rupture.

Applicant submits that this claim 5 is not obvious in view of the Logsdon reference, and respectfully requests that this rejection to claim 5 be withdrawn.

Prior Art

The cited prior art made of record but not relied upon has been reviewed by Applicant and is considered to be less pertinent than the references used in the rejection of the claims. None of the cited prior art of record individually or in combination overcome the deficiencies of the Logsdon patent, Frey et al. patent or Kuffel patent.

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Conclusion

In view of the above amendments to the claims and Applicant's remarks, claim 1 is not anticipated or obviated by any of the references to Logsdon, Frey et al. or Kuffel individually or in combination. Additionally, further dependent claims 4-7, 21 and 22 are not anticipated for at least the reasons claim 1 is not anticipated and the claims are believed not to be obvious in view of these references individually or in combination since none of these references either alone or in combination, discloses, teach, or suggest the limitations set forth in amendment claim 1 and in the remaining dependent claims.

Applicant respectfully requests that the rejections of the claims be withdrawn and allowance of pending claims 1, 4-7 and 21-22 are respectfully requested.

Respectfully submitted,

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